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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,908	09/12/2003	Tonja Lynn Andreana	PC25095A	6368

28880 7590 06/08/2006

WARNER-LAMBERT COMPANY
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EXAMINER
BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/660,908	ANDREANA ET AL.	
	Examiner	Art Unit	
	Emily Bernhardt	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8,13-16,31,49 and 50* is/are pending in the application.

4a) Of the above claim(s) *14-16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8,13,31,49-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

In view of applicants' response filed 3/27/06 the following applies.

Applicant's election without traverse of I in the reply filed on 3/27/06 is acknowledged.

The 112 rejections of the previous action have been overcome or rendered moot in view of cancellation of generic claims.

In amending claim 13's dependency, "49" is barely legible. If a response to this action will be made a clearer copy of the claim is requested.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Howard (EP'435). Upon review of the nomenclature for species in claim 8 it is noted that at least one species within claim 8 is anticipated by Howard. See last species on p.3 of claim 8 which corresponds to species in Howard on line 16 of p.3 or eg.53. The examiner could not find additional species that anticipated claim 8 since the species were slightly different than those in Howard.

Claims 8,13,31 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard (EP'435). If the anticipatory subject matter in claim 8 is removed claim 8 would still be obvious over Howard as all of the species covered

in 8 are analogs of that taught and exemplified by Howard.For example, many of the benzisoxazolyl species in claim 8 are identically substituted with corresponding benzoisothiazolyl species in Howard beginning with eg.39 –45. 9th species on p. 3 of claim 8 differs from eg.49 in Howard only in placement of methyl group on benzene ring- i.e. at 7- vs. instant 8-position. Other species are homologs such as 3rd last species on p.3 with eg.51 in Howard or contain a methyl group at a different ring position such as 3rd last species in claim 8 vs. eg 53 in Howard. New claims 49 and 50 are position isomers of eg.51 since Cl is at the 7-position vs. instant 8. Howard teaches all these variations as can be seen in the definitions of the variables within formula I. Thus it would have been obvious to one skilled in the art at the time the instant invention was made to modify the many species in Howard by replacing the azole core with cores recited herein and/or place methyl groups at various ring positions and/or alter the alkylene chain corresponding to instant "A" and in so doing obtain additional compounds with the expectation that they too will possess the uses taught by the art in view of the many equivalency teachings pointed out above.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is

not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 8,13,31 and 49-50 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/672949. Although the conflicting claims are not identical, they are not patentably distinct from each other because the species embraced herein differ from those in the copending case only in point of attachment to the 3,4 dihydroquinolin-2-one- at the 6-position herein vs at the 8-position in the copending case. Position isomers are not deemed patentably distinct absent evidence of superior, and unexpected results. See In re Crounse 150 USPQ 554;Ex parte Engelhardt 208 USPQ 343 regarding position isomerism. Thus it would have been obvious to one skilled in the art at the time the invention was made to expect instant 6-substituted quinoline derivatives to possess the same uses described in the

copending case for the 8-isomers in view of the close structural similarity outlined above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/672949, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C.

102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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E Bernhardt

Emily Bernhardt
Primary Examiner
Art Unit 1624